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EXAMINER

PATTERSON, MARIE D

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3728

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 10/039,338
Filing Date: October 29, 2001
Appellant(s): DEACON ET AL.

Ira C. Edell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/14/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is substantially correct. It is noted that applicant has chosen in the brief to use the term "protrusions" for elements 15, however in the specification as originally filed the only term used to describe element 15 is "ribs". Specifically on page 6 lines 10-20 and page 7 line 21- page 8 line 5 applicant describes the definition of a rib as a vertical ridge in the bottom surface of the flange. The only instance in the original specification of the term "protrusions" is used to describe the prior art on pages 2 and 3.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 18-34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,583,082	JORDAN, JR	6-1971
2,491,596	ZALESKI ET AL	12-1949

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 18-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 18-25 the phrase "traction means" is considered to be new matter because it was introduced into the application subsequent to the filing of the application. A means plus function recitation in construed to cover the corresponding structure, material or acts described in a specification and equivalents thereof. Addressing the particular facts of the present case, appellants only disclosed "ribs", with no mention whatsoever of any alternatives or equivalents thereof at the time of the filing of the application. Thus, one skilled in the art, reading the original disclosure, would not have

been informed of appellants' interest in or possession of equivalents, now claimed as part of the means plus function recitation. In this case by introducing a means plus function recitation into the present application, subsequent to its filing date (the filing date of the original parent application), appellants have , in effect, added to the original disclosure equivalents of the ribs. Thus, this late introduction of a means plus function recitation adds new matter (equivalents) to the application since the means plus function recitation lacks a descriptive basis as to the inclusion of any equivalents in the original disclosure.

3. Claims 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 18-25 the phrase "traction means" is vague and indefinite. The disclosed ribs are readily found to be the corresponding structure described in the specification (sixth paragraph of 35 USC 112) but the "equivalents" of the ribs in this art, as ribs are defined by appellants, are not characterized. For this reason the metes and bounds of the claims are uncertain or indefinite.

Claim Rejections - 35 USC § 102

4. Claims 18-20, 22, 26-30, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan, Jr. (3583082).

Jordan, Jr. shows a tract shoe cleat that may be used on synthetic turf. Jordan, Jr. seeks to overcome a damage problem that accrues from the use of long and sharp metal traction spikes that penetrate a track surface (column 1, lines 21-40). A cleat is

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disclosed that comprises a disc-shaped body having a plurality of bristles downwardly extending therefrom (column 1, lines 68-70). The bristles can reasonably be viewed as protrusions. These bristles are indicated to have sufficient stiffness so that they won't collapse or break when supporting the weight of an athlete (column 2, lines 25-27).

Jordan, Jr. sets a lower limit of about 10 bristles per square inch (column 2, lines 41-42). Further, Jordan, Jr. states "in use, the bristle spikes are most effective when they result in indentation of the running surface as opposed to penetration of the surface" (column 2, lines 51-53). It is for the latter reason that "the ends of the bristles need not be pointed" (column 2, lines 53-54). Claims 3 and 9 of Jordan, Jr. reveal a length of between about 1/16 inch and 1/4 inch for the bristles. Considering the disclosed density of about 10 bristles per inch it is clear that one skilled in the art would understand that the underside of the circular disc (flange) would be exposed between bristles and would also be capable of distributing weight over turf being walked on, while the bristles additionally support weight and provide traction. Based upon the overall Jordan, Jr. teachings, it is quite apparent that one skilled in the art would have fairly expected the bristles (protrusions) of Jordan, Jr. to provide traction without doing damage to the turf surface being walked on and without puncturing turf.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan, Jr..

Jordan, Jr. discloses the claimed invention except for the exact material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polyether block urethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claims 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan, Jr. in view of Zaleski (2491596).

Jordan, Jr. shows a cleat substantially as claimed except for the exact shape of the flange. Zaleski teaches making a flange (figure 4) portion of a cleat with a concave upper surface and a convex lower surface as an alternative to a planar shaped flange (see figure 1). It would have been obvious to make the flange shaped as taught by Zaleski in the cleat of Jordan, Jr. to make the cleat press more securely to the sole and to prevent dirt and debris from collecting under the flange.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 18-34 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,354,021 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claim cleats having a flange, attachments means, and traction means which provide traction without damaging turf. All of the independent claims (claims 1 and 10) in the patent correspond to all of the independent claims of this application, the claims of this application merely recite the broader claim language of "means" in place of the specific element which is recited in the prior patent. The dependent claims 19-25 and 28-33 of this application correspond to claims 2-5, 8, 9, 7, 2, 4, 5, 8, 9, and 7 of the patent respectively.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

10. Claims 18-34 are rejected under the judicially created doctrine of double patenting over claims 1-10 of U. S. Patent No. 5,259,129 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claim cleats having a flange, attachments means, and traction means which provide traction without damaging turf. . All of the independent claims (claims 1 and 10) in the patent correspond to all of the independent claims of this application, the claims of this application merely recite the broader claim language of "means" in place of the specific element which is recited in the prior patent. The dependent claims 19-21, 28, and 29 of this application correspond to claims 1 and 10 of the patent. Claims 25 and 33 of this application correspond to claim 4 of the patent. Claims 22 and 30 correspond to claim 9 of the patent. Claims 23, 24, 31, and 32 correspond to more specific design choice alternatives to the broadly recited shapes of the ridges recited in claims 1-10 of the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

(11) Response to Argument

In response to applicants' arguments directed towards the 112 first and second paragraph rejections, the specification as originally filed did not state "traction means such as ribs" or any other statement that provides basis for there being other or could be other structures that are equivalent to the ribs that would perform the desired functions recited throughout the specification, therefore entry of the phrase and subject matter of "traction means" after the original filing date does attempt to enter New Matter.

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The specification and drawings only refer to "ribs" and the specification on the bottom of page 7 clearly defines "ribs" as "more than one vertical ridges in the bottom of surface of the flange". The only variations discussed are variations to the arrangement, location, shape of the edges of the ridges, cross-section shape of the ridges (pages 6-8 of the original specification). There is no disclosure as to what structures would be equivalents, therefore it is not clear what structural limitations applicant intends to encompass with such language. Since there is no guidance as to what elements would be considered to be equivalents and applicant even argues that structures the Examiner would consider to be equivalents are not, the Examiner is at a loss as to what structures would be considered to be equivalents. The Examiner has applied a 112 second paragraph rejection because in view of applicants' arguments that the structures which the Examiner considers to be "traction means" are not "traction means", i.e. equivalents to the ribs disclosed, the Examiner is not able to determine the clear meaning and bounds of the claims and therefore the claim language is considered to be vague and indefinite because the structures which applicant intends to encompass with the language is not able to be determined. The Examiner has applied art to the claims which contain the new matter and vague and indefinite phrases as a courtesy to applicant to provide a full and complete office action. The Examiner has examined the claim language, which includes vague and indefinite phrases, to the best of her ability inasmuch as the claims are understood by the Examiner. It is true that applicant may broaden and use mean plus function language, this does not mean that applicant may after filing enter additional subject matter. There was no mention whatsoever of any

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alternatives or equivalents thereof at the time of the filing of the application, thus one skilled in the art, reading the original disclosure, would not have been informed of appellants' interest in or possession of equivalents, now claimed as part of the means plus function recitation. There is no disclosure or guidance as to what equivalents would be or how to determine such. A specification must set forth an adequate disclosure showing what is meant by means-plus-function language in a claim (See *In re Donaldson*, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)). The Examiner does not have a clear understanding of what applicant considers to be an equivalent to the ribs disclosed and therefore there is no basis in the specification for this language and the language is vague and indefinite.

The examiner has reviewed the case law cited by applicant, but finds the decisions and opinions expressed therein to be non-persuasive as to the subject matter and issues of this specific application. The question of New Matter and indefiniteness is so closely tied to the facts of each particular case, that prior decisions in cases involving different facts and specification are ordinarily of little value in reaching a decision.

In response to applicants' arguments directed towards Jordan, Jr., the flange of the cleat shown and disclosed by Jordan, Jr. is clearly capable of bearing weight inasmuch as applicant has defined such in the specification and claims. It would appear that the elements which bear weight would depend on the surface which is being walked on, i.e. on a sandy based soil it would appear that the entire bottom surface of the cleat, including the flange and protrusions would contact the sand and be weight bearing to some degree. In reference to applicants' definition of "turf" as "the upper stratum of soil

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bound by grass and plant roots into a thick mat" or "a surface layer of earth containing a dense growth of grass and its mated roots", there is nothing in these definitions which require a certain type of soil. Soils are made up of different proportions of sand, clay, and loam. Some soils are extremely sandy while others are very hard clay. The level of weight supporting and what elements do such would depend on the specific type of soil in the turf. Since Jordan does show all of the positively claimed structures, the cleat of Jordan is considered to inherently be capable of performing the recited functions. It is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corporation v. Brenner, 156 USPQ 163, 854 OG 844)

In response to applicants' argument that the cleat of Jordan would puncture the turf, there is no grounds for such in the reference. Jordan clearly does not intend the traction means to penetrate the track surface and recites that this prevention is based upon the particular track surface and can be "controlled with the structure of this invention by properly maintaining the size and density of the bristles" (see column 2 lines 51-62). Jordan also clearly states "different track surfaces will, however, undoubtedly be encountered by individual runners, the spikes are preferably removable so that variation can be employed" (column 2 lines 63-69). The examiner considers "turf" to be one such track surface inasmuch as the claims recite such. Jordan clearly states that the spikes result in "penetration of the running surface as opposed to penetration of the surface" (column 2 lines 50-53). There is nothing in Jordan that suggests a "penetrating" of any surface.

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In response to applicants' argument that the bristles/protrusions of Jordan are not "resilient", Jordan uses "tough plastic, for example, nylon or polycarbonate varieties....the bristles could be formed of metal or any other suitable material" (column 2 lines 30-33), these materials are considered to be resilient inasmuch as applicants durable plastic, polyether block urethane, is considered to be resilient, i.e. "springing back into shape, position, etc. after being stretched, or bent" (Webster's New World Dictionary, 3rd college edition). If one were to laterally bend the bristles of Jordan, they would inherently spring back into shape and position. The fact that they are stiff does not mean that they are not also resilient.

In response to Applicant's arguments that Jordan Jr. is not intended to be used, i.e. has not been disclosed as being used, for golfing, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The cleat of Jordan is clearly capable of being used on turf or for golfing.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Marie Patterson

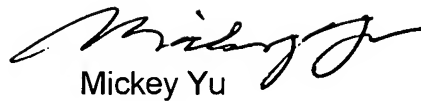
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